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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/199,874	11/24/98	SEGRE	G 00786071005

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HM12/0507

EXAMINER

PAK, M

ART UNIT	PAPER NUMBER
1646	<i>20</i>

DATE MAILED: 05/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/199,874

Applicant(s)

Segre et al.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 21, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 40-51 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 40-51 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

**DETAILED ACTION**

**Election/Restriction**

1. Applicant's election without traverse of newly submitted claims in Paper No. 19 is acknowledged.

Applicant elected neither of the two restriction groups set forth in the restriction mailed 18 December 2000 (Paper No. 17) and elected to prosecute method claims set forth in the new claims submitted in the amendment filed 21 February 2001 (Paper No. 19). Claims 1, 6-8, 10-12, 20-21, 23-25, and 39 are cancelled.

New restriction is set forth below.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 40-43, drawn to a method of identifying a compound by binding a polypeptide with a parathyroid hormone, classified in class 435, subclass 7.2.

II. Claims 44-47, drawn to a method of identifying a compound by binding a polypeptide with a parathyroid hormone related protein, classified in class 435, subclass 7.2.

III. Claims 48-51, drawn to a method of identifying a compound by binding a parathyroid hormone with a cell, classified in class 436, subclass 501.

The inventions are distinct, each from the other because of the following reasons:

The methods of inventions I-III, are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications and the search required for any one of inventions I-III is not required for any other invention I-III, thus, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

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Official papers filed by fax should be directed to (703) 308-4242.  
Faxed draft or informal communications with the examiner should be directed to  
(703) 308-0294.

Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the Group receptionist whose  
telephone number is (703) 308-0196.

*Michael D. Pak*

Michael D. Pak  
Primary Patent Examiner  
Art Unit 1646  
4 May 2001